

REMARKS

The present amendment is in response to the Official Action mailed January 7, 2009. Claims 7-9 and 10-21 remain pending for consideration. Claim 7 has been amended. No new matter has been introduced. The following sets forth the Applicant's remarks pertaining to the currently pending claims and the outstanding Action.

In the Office Action, the Examiner rejected claim 7 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 958,854 to Bunn ("*Bunn*"). In response, Applicant respectfully submits that the Examiner has not made a *prima facie* case of anticipation. In order to make a *prima facie* case, the Examiner must show that the prior art reference discloses all of the features on the claimed invention. *Bunn* does not disclose "an elongated opening therethrough in communication with said bore for viewing said guide wire trailing end." Indeed, the trailing end of the scraper 2 of *Bunn*, which the Examiner calls a guide wire, extends beyond the end of tube 1, well outside any view that may be provided of the scraper through branch 5, which the Examiner equates with the opening of the claimed invention. In addition, Applicant has amended claim 7 to recite "an elongated opening." This amendment is supported in paragraph [0008] of the specification. The opening of *Bunn* is clearly not elongated. See *Bunn*, FIGS. 1 and 2. Because *Bunn* does not disclose all of the features recited in claim 7, Applicant submits that the anticipation rejection is traversed and respectfully requests removal of same.

In addition, the Examiner rejected claims 8-9 and 19-21 under 35 U.S.C. § 103(a) as obvious over *Bunn* in view of German Patent No. DE 3800482 to List ("*List*"). In response, Applicant respectfully submits that the Examiner has not made a *prima facie* case of obviousness. In order to make a *prima facie* case, the Examiner must show, among other things, that 1) the

prior art references teach or suggest all of the claim limitations and 2) there is a motivation or suggestion to combine the references.

First, as discussed above with respect to *Bunn*, neither reference relied on by the Examiner discloses an opening in communication with a bore for viewing a guide wire trailing end, as required by independent claims 7 and 19. The trailing end of the scraper 2 in *Bunn* extends well beyond the view provided by branch 5, and *List* does not disclose a guide wire or any analogous structure. Thus, the prior art references relied on by the Examiner fail to teach or suggest all of the claim limitations.

Second, there is no suggestion or motivation to combine the *Bunn* and *List* references. If the modification proposed by the Examiner would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Claims 7 and 19 require a "drive end having an opening therethrough in communication with said bore for viewing said guide wire trailing end" and "a guide wire . . . having a trailing end viewable through the windows in the shank."

Bunn discloses a trocar for drawing liquids and gases out of live or dead organisms. The system of *Bunn* is a closed system, having a scraper disposed in the tube, and the tube extending from a position inside an organism at a leading end to a position outside the organism at a trailing end. There is included in the system of *Bunn* branch 5 that is configured to connect to a rubber tube for carrying off the matter withdrawn from the organism. Nowhere does *Bunn* disclose an opening for viewing a trailing end of a guide wire. If, as the Examiner suggests is possible, the tube or channel portion of the *Bunn* assembly were provided with an opening, as disclosed in *List*, the system of *Bunn* would no longer be closed. Thus, matter

withdrawn from an organism would escape through the opening provided in the tube or the branch and the device would cease to function as intended. Accordingly, Applicant respectfully submits that the obviousness rejections are traversed and requests removal of same.

Applicants further submit that claims 8-9 and 20-21, which depend from claims 7 and 19, constitute allowable subject matter at least by virtue of being dependent upon allowable independent claims. Moreover, such claims are believed to include additional patentable subject matter in their own rights.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 10/757,929

Docket No.: TRAUMA 3.0-452

If there are any charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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